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GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

JOO, JOSHUA

ART UNIT	PAPER NUMBER
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2154

DATE MAILED: 07/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/034,372

Applicant(s)

MASAO ET AL.

Examiner

Joshua Joo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

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1. Claims 7-12 are presented for examination.

Claim Objections

2. Claims 7 and 9 are objected to because of the following informalities:
 - i) As per claim 7, in the line "...according to a SMTP protocol, to convert the received...", the "," in the line should be a ";".
 - ii) As per claim 7, in the line "...to convert the received e-mail address of the recipient into URL data, to receive..." the "," in the line should be a ";".
 - iii) As per claim 7, in the line "...SMTP protocol, to convert the received e-mail data...", the "," in the line should be a ";".
 - iv) As per claim 7, in the line, "...into HTML data, and to transmit...", the "," in the line should be a ";".
 - v) As per claim 9, in the line "...according to a HTTP protocol, to convert the received...", the "," in the line should be a ";".
 - vi) As per claim 9, in the line "...Internet facsimile apparatus, to receive...", the "," in the line should be a ";".
 - vii) As per claim 9, in the line "...according to the HTTP protocol, to convert the received HTML data...", the "," in the line should be a ";".
 - viii) As per claim 9, in the line "...HTML data into e-mail data, and to transmit to the receiving...", the "," in the line should be a ";".

The semi-colons are needed to clarify the language in the claim to distinguish each separate process. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. Claim 7 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) In the line "an e-mail to which scanned image data is attached", "scanned image data" lacks proper antecedent basis. Is the "scanned image data" referring to the "facsimile apparatus scanning image data" previously mentioned in the claim?

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- ii) "the received e-mail address" lacks proper antecedent basis. Is "the received e-mail address" same as "a controller configured to receive... an e-mail address of the recipient"?

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 8, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen, US Patent #6,836,792 in view of Toyoda, US Patent #5,881,233 and Beer et al, US Patent #5,864,676 (Beer hereinafter).

6. As per claim 7, Chen teaches substantially the invention as claimed including the apparatus for receiving email messages and converting the email messages into HTML data. Chen's teachings comprise of:

a first communicator configured to be connected to a network (Col 2, lines 35-36.

Message is sent to the recipient. Communicator is inherent.);

a second communicator configured to be connected to an Internet apparatus (Col 1, lines 12-14. Internet.), the Internet apparatus transmitting, to a recipient via the communication control apparatus, an e-mail (Fig. 1; Col 1, lines 56-61. Sender transmits email to receiver over network via email system. Communicator is inherent.); and

a controller configured to receive, from the apparatus via the second communicator, an e-mail address of the recipient according to a SMTP protocol (Col 2, lines 1-10. Email system

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receives email message through SMTP. Col 1, lines 60-61. Email message includes the recipient email address.); to receive, from the receiving apparatus via the second communicator, e-mail data directed to the recipient according to the SMTP protocol (Col 2, lines 1-10. Receives email message through SMTP.); to convert the received e-mail data into HTML data (Col 2, lines 31-34. Convert email message into HTML.); and to transmit to the recipient, via the first communicator, the converted HTML data, according to a HTTP protocol (Col 1, lines 30-34; Col 7, lines 42-44. Converts email protocol to a protocol that may be displayed on web browser. Fig. 1; #152. Web server. HTTP is inherent.).

7. Chen teaches of transmitting email messages through a client apparatus (Fig. 1; #108A). However, Chen does not teach that the client apparatus is a facsimile apparatus that scans image data and transmits, to a recipient via the communication control apparatus, an e-mail to which scanned image data is attached.

8. Toyoda teaches of a facsimile apparatus that scans image data and transmits the image data via email (Col 29, lines 19-33).

9. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen and Toyoda because the teachings of Toyoda for a facsimile apparatus to scan an image and to transmit an email would improve the system of Chen's teachings by allowing different apparatuses to be implemented in Chen's systems to transmit email messages. Toyoda's teachings allow the sender to transmit email messages other than through the use of a computer. Toyoda's teachings also allow the receiver to receive HTML converted messages transmitted originally in email format by a facsimile apparatus.

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10. Chen teaches of converting email format into a protocol that may be displayed on a web browser (Col 7, lines 42-45). However, Chen does not specifically teach of converting the received e-mail address of the recipient into URL data and transmitting based on the converted URL data.

11. Beer teaches of converting email address into URL data (Col 4, lines 10-30).

12. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen and Beer because both teachings deal with converting email based protocol into a web based protocol. Furthermore, the teachings of Beer to convert the email address into URL data would improve the teachings of Chen by allowing the receiver to use its email address as a domain name, allowing the receiver to access the email information with just a web browser.

13. As per claim 8, Chen does not teach the communication control apparatus according to claim 7, wherein the controller converts the e-mail address of the recipient into the URL data by converting an @ mark in the e-mail address of the recipient into a dot and adding HTTP:// at the beginning of the e-mail address of the recipient.

14. Beer teaches of converting an email address to an URL, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address (Col 4, lines 10-30).

15. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen and Beer because both teachings deal with converting email based protocol into a web based protocol. Furthermore, the teachings of Beer to convert an email address, where the "@" is replaced with a dot and HTTP:// is added to the beginning of

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the converted email address would improve the teachings of Chen by allowing the receivers to access converted email by URL and by specifying the process of the conversion from email based protocol to a web based protocol. Beer's teachings also allow receivers to access their converted email information on a public computer system with just a web browser.

16. As per claim 11, Chen teaches substantially the invention as claimed including the method for receiving email messages and converting the email messages into HTML data.

Chen's teachings comprise of:

receiving, from the Internet apparatus, an e-mail address of a recipient according to a SMTP protocol (Col 2, lines 1-10. Email system receives email message according to SMTP. Col 1, lines 60-61. Email message includes the recipient's email address.);

receiving, from the receiving Internet apparatus, e-mail data directed to the recipient according to the SMTP protocol (Col 2, lines 1-10. Email system receives email message according to SMTP.);

converting the received e-mail data into HTML data (Col 2, lines 31-34. Convert email message into HTML.); and

transmitting, to the recipient via the first communicator, the converted HTML data according to a HTTP protocol (Col 2, lines 30-36. HTML data is send to recipient. Col 7, lines 42-44. Converts email protocol to a protocol that may be displayed on web browser. Fig. 1; #152. Web server. HTTP is inherent.).

17. Chen teaches of transmitting email messages through a client apparatus (Fig. 1; #108A). However, Chen does not teach that the client apparatus is a facsimile apparatus that

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scans image data and transmits, to a recipient via the communication control apparatus, an e-mail to which scanned image data is attached.

18. Toyoda teaches of a facsimile apparatus that scans image data and transmits the image data via email (Col 29, lines 19-33).

19. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen and Toyoda because the teachings of Toyoda for a facsimile apparatus to transmit an email would improve the system of Chen's teachings by allowing different apparatuses to be implemented in Chen's systems to transmit email messages. Toyoda's teachings allow the sender to transmit email messages other than through the use of a computer. Toyoda's teachings also allow the receiver to receive HTML converted messages transmitted originally in email format by a facsimile apparatus.

20. Chen teaches of converting email format into a protocol that may be displayed on a web browser (Col 7, lines 42-45). However, Chen does not specifically teach of converting the received e-mail address of the recipient into URL data and transmitting based on the converted URL data.

21. Beer teaches of converting email address into URL data (Col 4, lines 10-30).

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Chen and Beer because both teachings deal with converting email based protocol into a web based protocol. Furthermore, the teachings of Beer to convert the email address into URL data would improve the teachings of Chen by allowing the receiver

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to use its email address as a domain name, and allows the receiver to access the email information with just a web browser.

23. Claims 9, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tada, US Patent #6,237,040, in view of Toyoda and Beer.

24. As per claim 9, Tada teaches substantially the invention as claimed including the apparatus for receiving HTML data from a web browser, converting the HTML into email data, and transmitting the email data through SMTP. Tada's teachings comprise of:

a first communicator configured to be connected to a network (Col 7, lines 26-32.

Provider apparatus receives HTML data. Communicator is inherent.);

a second communicator configured to be connected to a receiving Internet apparatus (Fig.1. Provider apparatus is connected to user apparatus.), the receiving Internet apparatus receiving, from a transmitter via the communication control apparatus, an e-mail (Col 7, lines 33-36. Provider apparatus transmits email to user apparatus.);

a controller configured to receive, from the transmitter via the first communicator, HTML data according to the HTTP protocol (Col 7, lines 30-31. Receives HTML data using the HTTP protocol.); to convert the received URL data into an e-mail address of the receiving Internet apparatus (Col 7, lines 27-35. HTML data is send by WWW browser and transmitted over SMTP. Col 5, lines 18-26. Email addressed to user is converted to HTML file.); to convert the received HTML data into e-mail data (Col 7, lines 33-36. Converts HTML data into email data.); and to transmit to the receiving Internet apparatus, via the second communicator, the converted e-mail data, based on the converted e-mail address, according to a SMTP protocol (Col 7, lines 33-36. Receives email data based on SMTP protocol.).

25. Tada teaches of a second communicator configured to be connected to an apparatus (Fig. 1; Col 7, lines 33-36.) Tada does not teach that the receiving apparatus is a facsimile apparatus, where the facsimile apparatus receives, from a transmitter via the communication control apparatus, an e-mail to which image data is attached and printing the image data attached to the received e-mail.

26. Toyoda teaches of facsimile apparatus that receives email, where a printer is integrated into the facsimile apparatus (Col 29, lines 19-25) that allows for printing image data (Col 32, lines 66-67).

27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teachings of Tada and Toyota because the teachings of Toyota for a facsimile apparatus to receive email data and to print the image data would improve the system of Tada by allowing different apparatuses in Tada's system to receive email data, and Toyoda's teachings allows users to receive email data without the use of separate computers.

28. Tada teaches of converting HTML data into URL. However, Tada does not specifically teach of converting the received URL data into an e-mail address of the receiving Internet apparatus.

29. Beer teaches the relationship between an email address and an URL and teaches of converting the between the two formats (Col 4, lines 10-30).

30. Even though Beer does not specifically teach of converting URL data to an e-mail address, Beer does teach of converting an email address to a URL. It would have obvious to

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one of ordinary skill in the art at the time the invention was made to use Beer's teachings to create a method of converting an URL into an email address by reversing Beer's process. To convert URL into email address would improve the teachings of Tada by specifying the process of conversion to allow the email data to be transmitted through the SMTP, and allows apparatuses with SMTP based applications to receive the email.

31. As per claim 10, Tada does not teach the communication control apparatus according to claim 9, wherein the controller converts the URL data to the e-mail address of the receiving Internet facsimile apparatus by deleting a HTTP:// in the received URL and converting a dot in the received URL into an @ mark.

32. Beer teaches the relationship between an email address and an URL and teaches of converting the between the two formats, where the "@" is replaced with a dot and HTTP:// is added to the beginning of the converted email address (Col 4, lines 10-30).

33. Even though Beer does not specifically teach of converting URL data to an e-mail address by deleting a HTTP:// in the received URL and converting a dot in the received URL into an @ mark, Beer does teach of converting an email address to an URL by adding HTTP:// to the email address and converting the "@" into a dot. It would have obvious to one of ordinary skill in the art at the time the invention was made to user Beer's teachings to create a method to convert URL into an email address by reversing Beer's process. To convert an URL into an email address by deleting HTTP:// in the URL and converting the dot into an "@" would improve the teachings of Tada by specifying the process of conversion to allow the email data to be transmitted through the SMTP, and the conversion allows apparatuses with SMTP based applications to receive the email.

34. As per claim 12, Tada teaches substantially the invention as claimed including the apparatus for receiving HTML data from a web browser, converting the HTML into email data, and transmitting the email data through SMTP. Tada's teachings comprise of:

receiving, from a transmitter, URL data according to a HTTP protocol (Col 7, lines 30-31. Receives HTML data using the HTTP protocol.);

receiving, from the transmitter, HTML data according to the HTTP protocol (Col 7, lines 30-31. Receives HTML data using the HTTP protocol);

converting the received HTML data into e-mail data (Col 7, lines 33-36. Converts HTML data into email data.); and

transmitting, to the receiving Internet apparatus, the converted e-mail data, based on the converted e-mail address, according to a SMTP protocol (Col 7, lines 33-36. Receives email data based on SMTP protocol.).

35. Tada does not teach that the receiving apparatus is a facsimile apparatus.

36. Toyoda teaches of facsimile apparatus that receives email, where a printer is integrated into the facsimile apparatus (Col 29, lines 19-25) for printing image data (Col 32, lines 66-67).

37. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teachings of Tada and Toyota because the teachings of Toyota for a facsimile apparatus to receive email data and to print the image data would improve the system of Tada by allowing different apparatuses in Tada's system to receive email data, and Toyoda's teachings allows users to receive email data without the use of separate computers.

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38. Tada teaches of converting HTML data into URL. However, Tada does not specifically teach of converting the received URL data into an e-mail address of the receiving Internet apparatus.

39. Beer teaches the relationship between an email address and an URL and teaches of converting the between the two formats (Col 4, lines 10-30).

40. Even though Beer does not specifically teach of converting an URL data to an e-mail address, Beer does teach of converting an email address to an URL. It would have obvious to one of ordinary skill in the art at the time the invention was made to use Beer's teachings to create a method to convert URL into an email address by reversing Beer's process. To convert URL into email address would improve the teachings of Tada by specifying the process of conversion to allow the email data to be transmitted through the SMTP. Furthermore, it would allow apparatus using SMTP based application to receive information.

Conclusion

41. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

42. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

43. The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

i) Flepp et al, US Patent #6,684,239, teachings of converting email message into HTML format.

ii) Briton, US Application #2002/0177757, teachings of converting HTML received by a web site into an email message.

44. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Friday 8 to 5.

45. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John A. Follansbee can be reached on 571 272-3964. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

46. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 13, 2005
JJ

 JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100